

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/901,623
Attorney Docket No. Q65328

REMARKS

I. Introduction

Pending claims 1-16 (sic: 17) have been examined.¹ Claims 1-4 are allowed.

Furthermore, in a telephone Communication with Applicant's representative, the Examiner indicated that claim 17 is allowed.² However, claims 5-16 are rejected under 35 U.S.C. § 112, first and second paragraphs.

By way of overview, Applicant overcomes the § 112, first and second paragraph, rejections of claims 5-16 as follows.

II. Claim Rejections -- 35 U.S.C. § 112, First Paragraph

Claims 5-16 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which allegedly was not described in the specification in such as way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For example, the Examiner alleges that "it appears that the specification does not have sufficient structural support for the 'two state sensor' and its function" (Office Action: page 2; *see also* claims 5 and 10). The Examiner concludes that "it is unclear from the specification what a 'two state sensor' is" and asks "is it a well known device with a well know structure or circuitry"?

¹ According to the Examiner, the status of claim 17 was inadvertently omitted from the Office Action.

² *See* Interview Summary dated February 11, 2004.

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Applicant respectfully disagrees with the Examiner's assertions and submits that one of ordinary skill in the art, at the time of Applicant's invention, would have recognized that a two-state sensor is a sensor that is capable of being in one of two possible states at a time. Furthermore, claim 5 expressly recites that the sensor "[changes] state when said parameter crosses a threshold".

By way of example and not by way of limitation, Applicant's specification describes a temperature switch that operates as a two-state sensor to switch between one of two possible states, *i.e.*, an opened state and a closed state (Applicant's specification: page 4, lines 7-17). In this example, when the temperature T_A being monitored at a point A crosses a predetermined threshold temperature S_A , the temperature switch changes state (Applicant's specification: page 4, lines 4-6).

Additionally, the Examiner alleges that "it also appears that the specification does not disclose what 'a three phase distribution bay' and its function are" (Office Action: page 2; *see also* claim 10).

Applicant respectfully disagrees with the Examiner's assertions and submits that one of ordinary skill in the art, at the time of Applicant's invention, would have recognized that a three-phase distribution bay is an example of high or medium voltage electrical equipment, which has live elements such as conductors (*e.g.*, bus bars or cables) and insulating parts, to be monitored (Applicant's specification: page 1, lines 5-11 and 13-26; and page 3, lines 25-29).

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Indeed, claim 10 is directed to an apparatus for monitoring high or medium voltage electrical equipment *such as a three-phase distribution bay*. However, in order to further improve the clarity of claim 10, Applicant amends claim 10 to remove the language “such as a three-phase distribution bay” (*see* MPEP § 2173.02). Applicant respectfully submits that this amendment is not intended to narrow the scope of the original claim, but is rather for precision of language and to explicitly recite within the claim what was believed to have already been implicitly defined therein. Accordingly, this amendment does not foreclose application of reasonable equivalents.

In view of the above, Applicant respectfully submits that claims 5-16 are sufficiently enabled under § 112, first paragraph. Consequently, Applicant respectfully requests that the Examiner withdraw the § 112, first paragraph, rejections of claims 5-16.

III. Claim Rejections -- 35 U.S.C. § 112, Second Paragraph

Claims 5-16 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claim 5 (*see also* claim 10), the Examiner alleges that it is unclear what a “two state sensor” and its functions is. This issue is addressed by Applicant above in Section II.

With regard to claim 10, the Examiner alleges that it is unclear what a “three phase distribution bay” and “a live element of the equipment” represent. The Examiner asks “are they

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shown in any of the drawings”? The issue of a “three-phase distribution bay” is addressed by Applicant above in Section II.

With respect to the Examiner’s issue with the recited “a live element of the equipment” (*see* claim 10), Applicant respectfully submits that one of ordinary skill in the art, at the time of Applicant’s invention, would have recognized that a “live” element is, for example, an element that has current flow within it, *e.g.*, a conductor with current flowing through it.

Furthermore, the Examiner notes that on line 5 of claim 10, “said conductor” has no antecedent basis.

Applicant amends claim 10 to further clarify that “said conductor” referenced the previously recited “live element” (*see also* claim 14). Applicant respectfully submits that these amendments are not intended to narrow the scope of the original claims, but are rather for precision of language and to explicitly recite within the claims what was believed to have already been implicitly defined therein. Accordingly, these amendments do not foreclose application of reasonable equivalents.

Further still, the Examiner also alleges that it is unclear how “said conductor” is interconnected and associated with the “three phase distribution bay” and the “live element”. The aforementioned amendments to claim 10 (*see also* claim 14) obviate these issues.

In view of the above, Applicant respectfully submits that claims 5-16 are sufficiently definite under § 112, second paragraph. Consequently, Applicant respectfully requests that the Examiner withdraw the § 112, second paragraph, rejections of claims 5-16.

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IV. Formal Matter

The Examiner provides a signed and initialed copy of the Form PTO-1449 submitted the IDS filed on August 30, 2001, thereby indicating consideration of the references cited therein.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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